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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,875	08/04/2003	Hassan M. Fathallah-Shaykh	047940-0148	5251
23524	7590	10/16/2008		
FOLEY & LARDNER LLP 150 EAST GILMAN STREET P.O. BOX 1497 MADISON, WI 53701-1497			EXAMINER ZHOU, SHUBO	
			ART UNIT 1631	PAPER NUMBER
			MAIL DATE 10/16/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/633,875

Applicant(s)

FATHALLAH-SHAYKH, HASSAN M.

Examiner

SHUBO (Joe) ZHOU

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1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 39-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28, 36-38, and 43-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

RCE

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/21/08 has been entered.

The amendment filed 7/21/08 is acknowledged and entered.

Consequently, claims 1-28 and 36-44 are currently pending, among which claims 1-28, 36-38, and 43-44 are under examination; and claims 16 and 39-42 have previously been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or species, there being no allowable generic or linking claim.

Applicant's arguments in response to the previous Office action mailed 7/21/08 have been fully considered but they are not deemed to be fully persuasive. The following rejections and/or objections are either reiterated from the previous Office action or newly applied but necessitated by applicant's amendments, and constitute the complete set presently being applied to the instant application. Rejections and/or objections set forth in the previous Office action but not reiterated herein are hereby withdrawn in view of the amendments and applicant's arguments.

Claim Rejections-35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-28, 36-38, and 43-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Note that while this rejection is reiterated from the previous Office action, the reasoning is new necessitated by recent case laws and Office policies.

The claims are drawn to a method for eliminating indistinguishable differentials from a comparison of a pair of samples, comprising: measuring a property of a first sample and a second sample; comparing the measured property of the two samples to identify differences between the measured properties of the two samples; generating a data matrix for each sample; ranking the data points of each matrix from highest to lowest according to intensity such that a plot of rank versus intensity of the data points for each matrix provides an experimental curve for each matrix; fitting a smooth curve to each experimental curve to provide a model curve for each matrix, each model curve comprising a first section separated from a second section by an inflection point; eliminating any pair of corresponding data points for which each data point of the pair is below the inflection point of its model curve; and eliminating any pair of corresponding data points for which the rank of each data point of the pair is below a selected cutoff rank.

Since the claims are drawn to a method that also involves judicial exception, the following analyses of facts of this particular patent application follows the rationales suggested

in the Office's guidance to examiners under the Memorandum "Clarification of 'processes' under 35 USC § 101" (published May 15, 2008, available online www.uspto.gov/web/patents/memorandum.htm) and the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (OG Notices: 22 November 2005, available from the US PTO website at <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/og200547.htm>), which is incorporated in the MPEP 2106.IV.C.2.

Paragraph three of the Memorandum states:

"Based on Supreme Court precedent¹ and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.² If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and should be rejected as being directed to nonstatutory subject matter."

The methods of the instant claims are not tied to another statutory class (such as a particular apparatus) either explicitly or inherently. Nominal or token recitations will not suffice, e.g. displaying, inputting, obtaining, etc. See ex parte Langemyr; Appeal 2008-1495, decided May 28, 2008. Reciting another statutory class in the preamble does not make the invention tie to the statutory class. Furthermore, in the instant invention, there is no physical transformation because a process of generating data matrix, ranking data points, fitting a smooth curve, etc. as in the claims do not transform an article or physical object to a different state or thing. Therefore, the claimed method is not statutory process and thus non-statutory.

Claim Rejections-35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-28, 36-38, and 43-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The claims are amended to recite “displaying any corresponding pairs of corresponding data points not eliminated by step (c) to a user.” Applicant points to paragraph [0084]-[0086] of the specification for support therefor. However, a review of these paragraphs did not reveal adequate support for such “displaying any corresponding pairs of corresponding data points not eliminated by step (c) to a user.”

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shubo (Joe) Zhou, whose telephone number is 571-272-0724. The examiner can normally be reached Monday-Friday from 8 A.M. to 4 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran, can be reached on 571-272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the

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problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/Shubo (Joe) Zhou/

SHUBO (JOE) ZHOU, PH.D.

PRIMARY EXAMINER